

REMARKS

By the foregoing amendment, claims 1 and 25 are amended. Entry of the amendment, and favorable consideration thereof, is earnestly requested. Claims 10, 12 and 18-24 were cancelled previously. Claims 1-9, 11, 13-17 and 25 are currently pending.

Claims 1 and 25, the only independent claims, stand rejected under 35 USC § 103(a) as being unpatentable over Fletcher et al. (U.S. Patent No. 6,022,353) in view of Miller et al. (U.S. Patent No. 5,306,285) and Fieni (U.S. Patent No. 5,280,676). Applicant respectfully asks the Examiner to reconsider this rejection in view of the above amendments and the below remarks.

"To establish a prima facie case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. In re Vaecq, 947 F.2d 488 (Fed. Cir. 1991) see M.P.E.P. § 2143. This rule has recently been clarified as being flexible in allowing a reason to combine. KSR International Company versus Teleflex Inc., 550 U.S. ___, 2007 WL 1237837 (2007)."

The failure of the prior art to satisfy any single factor results in the failure of the prior art to obviate the present claims.

It is noted that claims 1 and 25 have been amended to require, inter alia, "an elongated member having a rearward first section, with a hole extending through said first section and having a closed rear wall formed by material from which said first section is made, said hole being configured to be mounted on said output shaft with a fastener having a predetermined thickness so that the member extends in a direction at least substantially normal to said predetermined axis", and "wherein said elongated member comprises a step of finite length at least equal to the thickness of the fastener intermediate said first and second sections thereof". These amendments are supported within the original description at page 15, lines 3-5 as well as Fig. 4.

As has already been recognized by the Examiner, neither Fletcher et al. nor Miller et al. discloses, teaches or suggests a stepped configuration, which is why the Examiner has cited Fieni. Thus, clearly neither Fletcher et al. nor Miller et al. can disclose a stepped configuration having the precise features added by the above amendment. Applicant respectfully submits that Fieni also does not disclose, teach or suggest these features.

It is respectfully submitted that Fieni is not directed to a tool for making workpiece cuts in combination with an apparatus having a power driven output shaft that oscillates about an axis. By contrast Fieni discloses a hand tool that includes a blade and a handle for removing shingles and nails from a roof. On a front edge of the blade there is a first plurality of teeth for removing shingles and nails on a forward manual stroke of the hand tool along the roof. On the rear edge of the blade, there is a second plurality of teeth for removing nails on a backward stroke of the hand tool along the roof. See column 2, lines 47–54. The nature of Fieni reveals that it is unsuitable for being driven in an oscillatory manner wherein the cutting edge might smoothly cut through a subject material. Instead, Fieni discloses that it is dedicated to the straight line, brute force shearing of roofing fasteners.

In addition, Fieni does not disclose or suggest a step that is configured so that the cutting edge of the elongated member extends in the plane of the second section. In present Office Action, page 3, lines 20–21 states that Fieni teaches an elongated member comprising a step 136 intermediate a first section 138 and a second section 135, as disclosed in Fig. 7. In the light of the clarifying amendments made to claims 1 and 25, this interpretation of Fieni is no longer tenable. Fieni provides no analogous first section for attachment to an oscillatory output shaft by a fastener, wherein a step between the first section and the second section are at least equal to the thickness of the fastener. If the teeth 124 of Fig. 6 of Fieni might be considered analogous to the cutting edge of the present application, then said teeth 124 are shown to be attached to the first section of Fieni. This is so because Fieni discloses no step between a first section and a second section, as provided in claims 1 and 25. In addition, the generally planar nature of the blade portion 114 (see Fig. 5b) shows no step at all. This is in direct contrast with claims 1 and 25, which disclose that the step has a length at least equal to the thickness of the fastener which secures the elongated member to the oscillatory output shaft. Fieni is significantly different because it is directed to solving a significantly different problem than that of claims 1 and 25.

A close reading of Fieni discloses no suggestion or motivation wherein the roofing removal tool of Fieni might be used to perform cutting in an oscillatory manner as part of a power tool. Fieni discloses only manual operation of the tool and such operations are limited to straightforward and backward motions (see Abstract). Thus, Fieni provides no suggestion or motivation to modify its arrangement for use in the manner according to claims 1 and 25.

The Fieni reference in combination with Fletcher et al. and Miller et al. fail to teach or suggest all the claim limitations. The present Office Action, page 3, lines 20–21 relies on Fieni to teach

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an elongated member comprising a step between first and second sections. Thus, the Examiner agrees that neither Fletcher nor Miller disclose the step arrangement as disclosed in claims 1 and 25. Further, the present amendments to claims 1 and 25 further distinguish claims 1 and 25 from the provided prior art.

Applicant respectfully submits that the prior art references, alone or in combination, fail to teach or suggest all claim limitations.

The third factor in the three-prong test for obviousness will not be addressed for the sake of brevity. The failure of the prior art references to satisfy both of the obviousness factors addressed to above, results in the failure of the prior art to obviate the present claims.

For the foregoing reasons, applicant respectfully submits that independent claims 1 and 25 are patentable over the prior art references. Accordingly, applicant respectfully requests that the rejections of claims 1 and 25 under 35 USC, section 103(a) be favorably reconsidered and withdrawn.

Since the dependent claims are patentable at least by virtue of their dependency on allowable claims 1 and 25, respectively, applicant respectfully requests that the rejections of the dependent claims under 35 USC, section 103(a) also be withdrawn.

In view of the foregoing remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby respectfully submitted.

Respectfully submitted,

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